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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/594,186	09/25/2006	Jose Barbosa Mendes Jr	40296-10010	7100
21788	7590	02/07/2008		
RYNDAK & SURI LLP 200 W. MADISON STREET SUITE 2100 CHICAGO, IL 60606			EXAMINER BLATT, ERIC D	
			ART UNIT	PAPER NUMBER
			3734	
			MAIL DATE	DELIVERY MODE
			02/07/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/594,186

Applicant(s)

MENDES JR ET AL.

Examiner

Eric Blatt

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 5-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 September 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>7-30-2007</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the teeth being longitudinally oriented on each leg and a longitudinal recess on the inner surface of one leg and a longitudinal ridge on the inner surface of the other leg must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 5, 6, 10-19, 23, and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Machado (US 694,934).

Regarding claims 5, 6, 10-19, 23, and 24, Machado discloses a surgical clip (Figure 1) comprising a pair of laterally curved legs 2, 3, a flexible articulation 7 joining the pair of legs at one end, and a locking mechanism 8 at a second end of the pair of legs for securing the legs together in a closed position. The locking mechanism comprises a pin 8 and an orifice located at the free end of the other leg, the pin being adapted to snap fit under pressure into the orifice. The clip is formed of metal. (Page 2, Column 1, Lines 6-20) The clip is also formed of polymer material. (Page 1, Column 2, Lines 95-100) The flexible articulation is integral with legs. Integral is broadly interpreted as mechanically connected. One leg 2 includes a longitudinal ridge 1 on its

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inner surface and the other leg includes a longitudinal recess on its inner surface, the ridge being adapted to fit within the recess when the clip is in the closed position.

Claims 5-8, 11, 12, 16-21, and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Laugherty et al. (US 3,854,482).

Regarding claims 5-8, 11, 12, 16-21, and 23, Laugherty discloses a pair of laterally curved legs 1, 2, a flexible articulation join 3 joining the legs at one end, and a locking mechanism 8, 10 at a second end of the pair of legs for securing the legs together in a closed position. The locking mechanism comprises a pin 8 at the free end of one leg and an orifice 10 located at the free end of the other leg, the pin being adapted to snap fit under pressure into the orifice. Each leg comprises a plurality of teeth 4 on its inner surface wherein said teeth are transversely oriented on each leg. The clip is formed of polymer material. (column 2, Lines 10-19) The flexible articulation is intergral with the legs.

Claims 5-8, 11, 12, 16-21, and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Wilson, Jr. (US 6,863,675).

Regarding claims 5-9, 11, 12, 16-21, and 23, Wilson recites a surgical clip (Figures 1, 2) comprising: a pair of laterally curved legs 22, 24; a flexible articulation 38 joining the pair of legs at one end; and a locking mechanism 42, 44 at a second end of the pair of legs for securing the legs together in a closed position. Regarding the limitation that the legs are 'laterally curved,' the direction the legs extend in is

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considered a longitudinal direction, and any direction perpendicular to this direction may be considered lateral depending upon the angle at which the clip is held. The locking mechanism comprises a pin 42 at the free end of one leg and an orifice 46 at the end of the other leg, the pin being adapted to snap fit under pressure into the orifice. Each leg includes a plurality of teeth 76 on its inner surface. The teeth 76 are transversely oriented on each leg. The clip is formed of polymer material. (Column 2, Lines 40-50) The flexible articulation 38 is integral with the legs. One leg has at least one protrusion 42 on its inner surface and the other leg having at least one recess 46 on its inner surface, the protrusion 42 and recess 46 being adapted to fit together when the clip is in a closed position.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laugherty et al. (US 3,854,482).

Regarding claims 9 and 22, all elements of said claims are disclosed by Laugherty except that the teeth are longitudinally oriented. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the apparatus of

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Laugherty by providing the teeth such that they are longitudinally oriented since such a modification would merely require a rearrangement of the existing parts of the device.

Claims 9, 10, 13-15, 22, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson, Jr. (US 6,863,675).

Regarding claim 10, Wilson discloses all elements of claim 10 except that the clip is formed of metal. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the apparatus of Wilson by having the clip be formed of metal since metal was known by those of skill in the art as an accepted material from which to form medical clips.

Regarding claims 13-15, and 24, Wilson discloses all elements of said claims except that one leg includes a longitudinal ridge on its inner surface and the other leg includes a longitudinal recess on its inner surface, the ridge being adapted to fit within the recess when the clip is in the closed position. Wilson does disclose a transverse ridge 76 and a transverse recess (indentation between ridges on opposing leg), the ridge being adapted to fit within the recess when the clip is in the closed position. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the apparatus of Wilson by having the ridge and recess be longitudinal since such a modification would have merely constituted a rearrangement of the existing parts of the device.

Regarding claims 9 and 22, Wilson discloses all elements of claims 9 and 22 except that the teeth are longitudinally oriented on each leg. Rather, Wilson shows that

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the teeth are transversely oriented on each leg. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the apparatus of Wilson by having the teeth be longitudinally oriented on each leg since such a modification would have merely constituted a rearrangement of the existing parts of the device.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Hulka; Jaroslav Fabian (US 3921641): Controlling forceps
- Spong; Alfred (US 6434803): Garment hanger positioning and locking device
- Whitehead; Peter D. et al. (US 5921991): Multi-colored umbilical cord clamp

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Blatt whose telephone number is (571)272-9735. The examiner can normally be reached on Monday-Friday, 9:00 AM-6:00 PM.

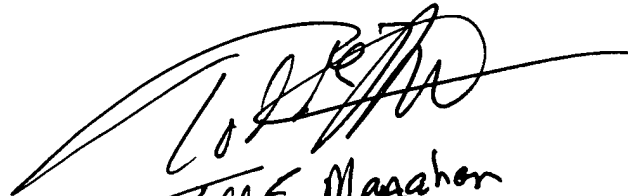
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on 571-272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Todd E. Maachen  
SPE 3731